

reference by including the perfluoroalkyl phosphate treated pigments of *Cernasov* in order to arrive at the presently claimed invention. More specifically, the Examiner has failed to provide evidence of any suggestion or motivation in either of the cited references to pick and choose the perfluoroalkyl phosphate treated pigments from the composition disclosed in *Cernasov* and use them in the composition disclosed in *the JP reference*.

The teaching of the perfluoroalkyl phosphate treated pigments in *Cernasov* is limited to a particular oil-in-water emulsion with specific dispersants. For example, *Cernasov* teaches that “[t]he dispersion of these physical sunscreens and pigment colorant elements is in the oily phase of the [O/W] emulsion, which comprises waxes and triglycerides This dispersion is implemented essentially by using a selection from among the large number of available dispersants” (col. 2, lines 19-24) and “the combination of this specific oily phase with the specific pigments led to a stable formulation” (col. 2, lines 7-9). (Emphasis added). Nowhere does *Cernasov* teach use of a polymeric gelling agent in the emulsion, nor does it suggest use of the perfluoroalkyl phosphate treated pigments together with a polymeric gelling agent, let alone the specific polyacrylamide-based polymer gelling agent as claimed in the present invention.

The sole reason the Examiner provides in support of the allegation of any suggestion or motivation to modify the teachings of *the JP reference* is because of “the expectation that the resulting formulation would have excellent moisture retention characteristics.” Office Action, page 3. However, *Cernasov* clearly teaches that “[t]he special inventive combination of pigments treated with perfluoroalkyl phosphates of (a)

and the dispersants of (b) in combination with the selected oily phase surprisingly results in a significantly higher moisture content for the skin than [what] was thought to be possible." Col. 2, line 63 - col. 3, line 1. In other words, *Cernasov* teaches that it is not the perfluoroalkyl phosphate treated pigment itself, but the combination of the perfluoroalkyl phosphate treated pigment with the dispersants and the selected oily phase, that leads to high moisture content for the skin. Therefore, the Examiner's allegation of a suggestion or motivation to modify is incorrect.

Second, the Examiner has failed to point to any evidence of a reasonable expectation of success in either of the cited references to pick and choose the perfluoroalkyl phosphate treated pigments from the composition disclosed in *Cernasov* and use them in the composition disclosed in *the JP reference*. In fact, to the contrary, *Cernasov* recognizes that one cannot simply pick and choose one ingredient from one composition and combine it with another composition without potentially changing the nature and stability of the final products. See col. 1, lines 12-14 and col. 2, lines 1-3.

Further, as pointed out during the interview, the color photos, the results shown on pages 4-5 of the Rule 132 Declaration submitted on March 5, 2004, and the results shown on page 11, Table I, of the originally filed specification indicate that when the fluorine compound treated pigment is used with agents other than the gelling agent recited in, for example, pending claim 1 of the present invention (*i.e.*, compositions 2, 3, and 8 in the Rule 132 Declaration and compositions 2 and 3 in the originally filed specification), the resulting compositions do not have satisfactory characteristics, such as stable gel formation and good lasting effects and sense of application on the skin, in

comparison with composition 1, which is in accordance with the presently claimed invention.

In response to the Examiner's allegation that "Applicants' 132 declaration does [not] give data on how the instant composition and the composition of the prior art affect skin," Applicants respectfully submit that such data have already been disclosed in the originally filed application on pages 10 and 11, *i.e.*, the results associated with the lasting effects and sense of application.

In addition, *Cernasov* teaches that "the combination of this specific oily phase with the specific pigments led to a stable formulation." Col. 2, lines 7-9 (emphasis added). As the composition disclosed in *Cernasov* is already a stable emulsion, the Examiner has failed to point to any evidence of a suggestion or motivation in either of the cited references to combine it with the composition disclosed in *the JP reference*. The only common characteristic of the composition disclosed in *the JP reference* and the composition disclosed in *Cernasov* is that both of them are directed to cosmetic compositions. However, using this common characteristic as the sole evidence in support of the requisite suggestion or motivation to combine is unacceptable, because it contradicts the requirement of specificity according to the existing case law. For example, the Federal Circuit has held that "[t]he factual inquiry whether to modify or combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." *In re Sang-Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (emphasis added).

Further, and more importantly, without reliance on the disclosure of the present invention as a blueprint, the Examiner has failed to point out any evidence of a reasonable expectation of success to combine the compositions disclosed in the cited references. Instead, combining *Cernasov's* composition, which is already a stable emulsion, with the composition disclosed in *the JP reference* could disrupt the stability of *Cernasov's* composition without forming another stable composition, given the fact that *Cernasov* teaches "[a] well-balanced composition is essential to achieving a stable emulsion." See *Cernasov*, col. 1, lines 10-11.

Even if, for purposes of argument, *Cernasov's* composition can be combined with the composition disclosed in *the JP reference* with a reasonable expectation of success, this does not mean that such a combination is obvious, because the Examiner has failed to point out any evidence of the desirability to combine in either of the cited references. See M.P.E.P. § 2143.01 ("[T]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (Emphasis in original and emphasis supplied)).

Finally, in order to support a proper rejection under 35 U.S.C. § 103, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998) (emphasis added). Here, even after *Cernasov's* composition is combined with the composition disclosed in *the JP reference*, in order to form the composition claimed in, for example, pending claim 1 of

the present application, one needs to pick and choose the perfluoroalkyl phosphate treated pigments disclosed in *Cernasov* and the polyacrylamide disclosed in *the JP reference* as two requisite components and use the dispersants disclosed in *Cernasov* as an optional component. Yet, the Examiner has not identified any teaching or suggestion in either of the cited references nor provided any reason to do so. In fact, as discussed above, *Cernasov* clearly teaches the importance of combining its perfluoroalkyl phosphate treated pigments with the dispersants in order to obtain a stable emulsion. Therefore, the Examiner has apparently adopted a hindsight approach, which is improper.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request this rejection be withdrawn.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, she is respectfully urged to contact Applicants' undersigned representative at 202-408-4218.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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